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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,473	10/24/2003	Karl Gramling	P-7988(CIP)	2555
30553	7590	01/09/2006	EXAMINER	
GUNN, LEE & HANOR 700 N. ST. MARY'S STREET SUITE 1500 SAN ANTONIO, TX 78205			LAUX, JESSICA L	
			ART UNIT	PAPER NUMBER
			3635	

DATE MAILED: 01/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/693,473	Applicant(s) GRAMLING, KARL	
	Examiner Jessica Laux	Art Unit 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 6-12 is/are rejected.
- 7) ☒ Claim(s) 2-5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>reference drawing</u> . |

DETAILED ACTION***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 6-7, and 9-12 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2 and 5-10 of U.S. Patent No. 6935074. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

claim 1 of the application and claim 2 of the patent both recite the structure of a gutter having a locking tip contiguous with a nib end, the nib end being adjacent a hanger portion which is contiguous with a u portion that is adjacent a vertical portion; where the hanger portion and the vertical portion are approximately parallel with the nib end angled outwardly from the hanger portion, and the locking tip is angled inwardly

Art Unit: 3635

toward the vertical portion from the nib end; and the hanger portion and locking tip fit in the gutter and retaining member.

claim 6 of the application and claim 5 of the patent recite further structure of the gutter clip above having a base adjacent the vertical portion;

claim 7 of the application and claim 6 of the patent recite further structure of the gutter clip above having an extension adjacent the base;

claim 9 of the application and claim 7 of the patent recite further structure of the gutter clip above having a first elbow between the vertical portion and the base;

claim 10 of the application and claim 8 of the patent recite further structure of the gutter clip above having a second elbow between the base and the extension;

claim 11 of the application and claim 9 of the patent recite further structure of the gutter clip above having a lower portion adjacent the extension;

claim 12 of the application and claim 10 of the patent recite further structure of the gutter clip above having an end adjacent the lower u-portion.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 6-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Schluter (5960591).

Art Unit: 3635

In regards to claim 1: Schluter discloses a gutter retaining system comprised of a clip (Figure 4, element 25), a retaining member (Figure 4, element 2), and a gutter (Figure 4, element 24). Schluter also discloses a gutter clip as having a locking tip (element A, see attached sheet) contiguous with a nib end (element B, see attached sheet), the nib end being adjacent to a hanger portion (element C, see attached sheet), the hanger portion being contiguous to a U portion (element D, see attached sheet), the U portion being adjacent to a vertical portion (element E, see attached sheet), the hanger portion and vertical portion being approximately parallel and the nib end is angled outward from the hanger portion and the locking tip is angled inward toward the vertical portion whereby the clip is locked within and between the gutter and retaining member (Figure 4).

In regards to claim 6: Schluter discloses a base adjacent the vertical portion (Figure 4).

In regards to claim 7: Schluter discloses an extension adjacent the base (Figure 4).

In regards to claim 8: Schluter discloses a back face mounted against the gutter back wall (Figure 4).

In regards to claim 9: Schluter discloses a first elbow between the vertical portion and the base (Figure 4).

In regards to claim 10: Schluter discloses a second elbow between the base and the extension (Figure 4).

Art Unit: 3635

In regards to claim 11: Schluter discloses a lower U portion adjacent to the extension (Figure 4).

In regards to claim 12: Schluter discloses an end adjacent the lower U portion (Figure 4).

Allowable Subject Matter

Claims 2-5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica Laux whose telephone number is 571-272-8228. The examiner can normally be reached on Monday thru Friday, 8:30am to 4:00pm (est).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on 571-272-6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3635

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JL
12/29/2005



Carl D. Friedman
Supervisory Patent Examiner
Group 3600

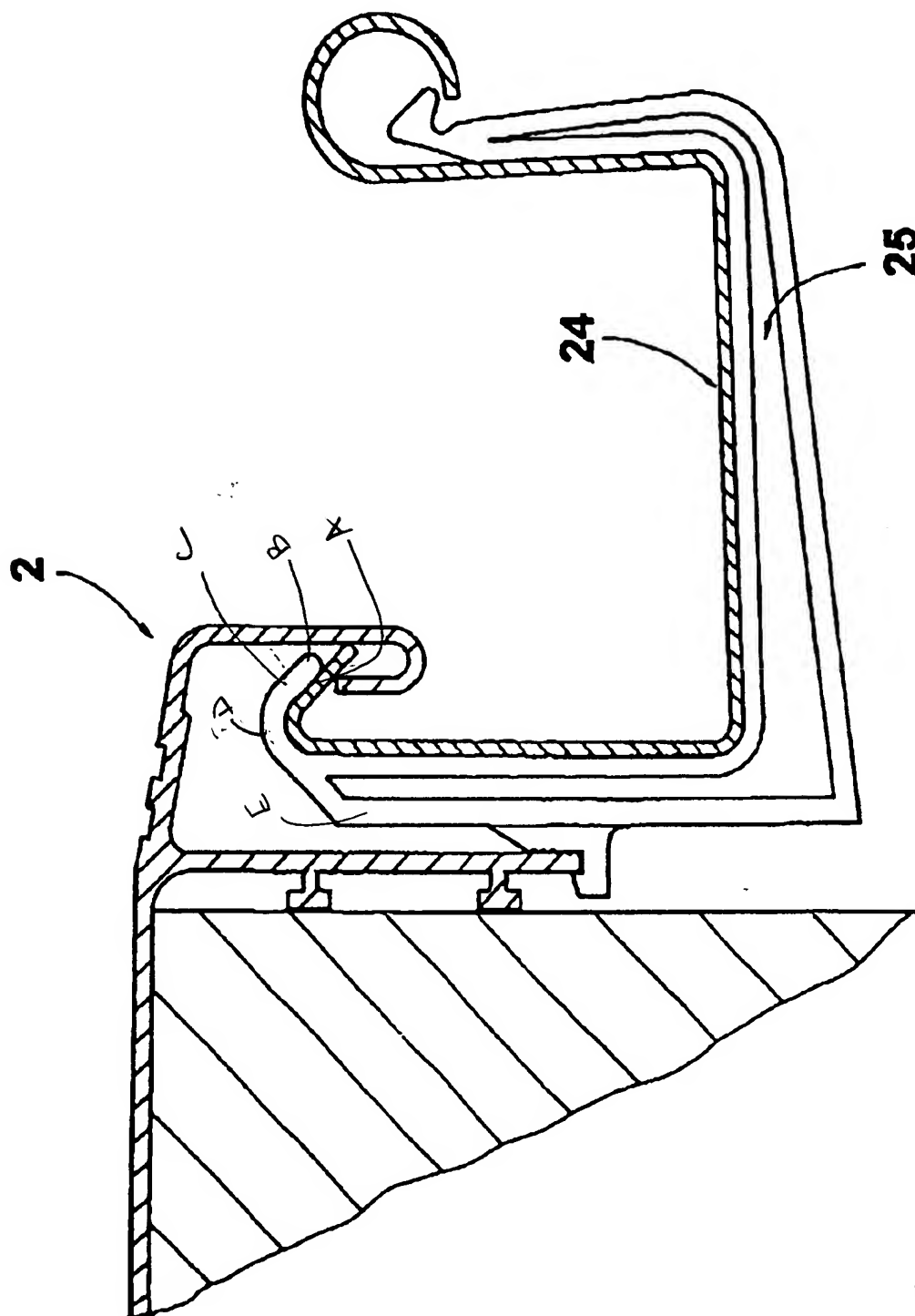


Fig. 4